

REMARKS

In the Final Office Action ("FOA"), the Examiner rejected claims 1, 4, and 5 under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2002/0007311 to Iseki et al. ("*Iseki*") and alternatively under 35 U.S.C. § 103(a) as obvious over *Iseki*; and rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over *Iseki* further in view of U.S. Patent No. 5,655,053 to Renie ("*Renie*"). By this amendment, Applicant adds new claim 6. Thus, claims 1-6 are pending and under current examination.

Applicant respectfully traverses the rejections of claims 1, 4, and 5 under 35 U.S.C. § 102(b) as anticipated by *Iseki* and under 35 U.S.C. § 103(a) as being obvious over *Iseki*.

Independent claim 1 recites, in part, a mobile recording medium "manufactured specifically for a place by a company for creating an original electronic album of the place," the mobile recording medium comprising "material information provided by the company that is pre-recorded on the mobile recording medium, the material information including at least one of text, an image, audio, and a map relating to the place."

Iseki does not teach or suggest at least the above-cited elements of claim 1. The Office states that "[i]n response to applicant's argument that the claimed 'mobile recording medium' is manufactured specifically for a place by a company... ' . . . a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." (FOA at 9.) Applicant respectfully submits that there is structural difference between the recited "mobile recording

medium" and *Iseki's* system. Indeed, *Iseki's* system is not a "mobile recording medium," let alone one that is "manufactured specifically for a place by a company." Instead, it is a system including an electronic service site connecting with a plurality of image provider terminals. (*Iseki* at para. [0035]).

In rejecting the claims under § 103, the Office claims that "[e]ven if *Iseki* did not explicitly teach that the mobile recording medium was manufactured specifically for a place by a company. . . it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the digital camera and/or storage medium to store the pre-recorded travel information, since it would have been obvious to combine the disclosed prior art elements of camera, storage, and pre-recorded images using the disclosed methods of using the camera as a terminal, in order to achieve predictable results (KSR)." (FOA at 4 and 7.) Applicant respectfully submits that the digital album registering and opening system taught by *Iseki*, which includes connecting a plurality of image provider terminals, image user terminals, and a travel agency terminal (para. [0035]), do not lead to the "predictable results" of a mobile recording medium "manufactured specifically for a place by a company for creating an original electronic album of the place."

Moreover, the Office's reasoning that "it would have been obvious to combine the disclosed prior art elements of camera, storage, and pre-recorded images using the disclosed methods of using the camera as a terminal, in order to achieve predictable results" are conclusory statements. Such statements do not amount to the required rationale for establishing a *prima facie* case of obviousness. As the court in KSR ruled, "rejections on obviousness cannot be sustained by mere conclusory statements;

instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.") quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))).

Claim 1 is therefore allowable. Claim 4 is allowable at least by virtue of its dependence from independent claim 1. Independent claim 5, while different in scope than claim 1, distinguishes over *Iseki* for at least similar reasons as claim 1. Accordingly, Applicant respectfully requests the withdrawal of the rejections of 1, 4, and 5 under 35 U.S.C. §§102(b) and 103(a).

Applicant respectfully traverses the rejections under 35 U.S.C. §103(a) of claims 2 and 3 as being unpatentable over *Iseki* further in view *Renie*. A *prima facie* case of obviousness has not been established at least because the differences between the prior art and Applicant's claims are such that it would not have been obvious for one of ordinary skill in the art at the time of the invention to modify the prior art to arrive at Applicant's claimed invention.

Claims 2 and 3 depend from independent claim 1, and thus, incorporate each and every element of claim 1. As discussed above, *Iseki* fails to teach or suggest at least a mobile recording medium "manufactured specifically for a place by a company for creating an original electronic album of the place," the mobile recording medium comprising "material information provided by the company that is pre-recorded on the

mobile recording medium, the material information including at least one of text, an image, audio, and a map relating to the place.”

Renie fails to cure the deficiencies of *Iseki*. *Renie* discloses a personalized video system for “acquiring video of an individual consumer as shot at an amusement park or the like and combining those images with standard, preshot video of rides or attractions” (Abstract). However, the standard preshot video of rides or attractions of *Renie* does not constitute material information that is pre-recorded on a “mobile recording medium” that is “manufactured specifically for a place by a company,” where the same company also provides “material information” that is “pre-recorded on the mobile recording medium,” as required by claim 1.

Claims 2 and 3 are therefore allowable over *Iseki* and *Renie*. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claims 2 and 3 under 35 U.S.C. § 103(a).

New claim 6 is allowable over *Iseki* because *Iseki* fails to teach or suggest at least “[a] method of creating an original electronic album of a place by a visitor,” the method including “selling [a] storage medium to the visitor at the place,” as recited in independent claim 6. Indeed, *Iseki* is silent with respect to “selling the storage medium to the visitor at the place.”

In view of the foregoing, Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing all pending claims in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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